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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/636,015	08/06/2003	Bruno Senn	IVd09US	9132

7590
John C. Thompson
69 Grayton Road
Tonawanda, NY 14150

11/17/2005

EXAMINER

TIBBITS, PIA FLORENCE

ART UNIT	PAPER NUMBER
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2838

DATE MAILED: 11/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/636,015

Applicant(s)

SENN ET AL.

Examiner

Pia F. Tibbits

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 June 2005 and 18 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8,10,11,14-17,19 and 20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8,10,11,14-17,19 and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 August 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>6/24/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

This Office action is in answer to the amendment filed 6/20/2005. Claims 1-8, 10, 11, 14-17, 19 and 20 are pending, and all pending claims are amended.

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the plurality of electrical supply contacts, the multiple-branch receptacle, etc. must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement-drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the examiner does not accept the changes, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

2. The amendment filed 6/20/2005 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material, which is not supported by the original disclosure, is as follows: **"the modules may be assembled", "the modules may be used in different pairings"**. Applicant is required to cancel the new matter in the reply to this Office Action.

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Claim Objections

3. Claims 17 is objected to because of the following informalities:

Claim 17: "the hand grip" lacks antecedence.

Art Rejection Rationale

4. At the outset, the examiner notes that claims are to be given their broadest reasonable interpretation in light of the supporting disclosure. *In re Zletz*, 893 F.2d 319, 321, 13 USPQ 2d 1320, 1322 (Fed. Cir. 1989); *In re Prater*, 415 F.2d 1393, 1404, 162 USPQ 541, 550 (CCPA 1969); *In re Yamamoto*, 740 F.2d 1569, 222 USPQ 934 (Fed. Cir.1984); *Burlington Indus. V. Quigg*, 822 F.2d 1581, 3 USPQZd 1436 (Fed. Cir. 1987); *In re Morris*, 43 USPQZd 1753, 1756 (Fed. Cir. 1997). ("During patent examination the pending claims must be interpreted as broadly as their terms reasonably allow.... The reason is simply that during patent prosecution when claims can be amended, ambiguities should be recognized, scope and breadth of language explored, and clarification imposed.... An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed, as much as possible, during the administrative process."). In responding to this Office action, applicants are reminded of the requirements of 37 CFR 1.111 and 1.119 that applicants specifically point out the specific distinctions believed to render the claims patentable over the references in presenting responsive arguments. See MPEP 714.02. The support of any amendments made should also be specifically pointed out. See MPEP 2163.06.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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6. Claims 1-8, 10, 11, 14-17, 19, 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over prior art disclosed by applicant, **WO-0160280** [hereinafter WO].

As to claim 1, the claim language was interpreted in light of the specification describing "service module 62 can also be installed or inserted into the hand-held device 10 in lieu of the connection module 24", i.e., either the service module **or** the connection module is used, not both. And further, the specification describes "a service module 62 (FIG. 6) can also be installed or inserted into the hand-held device 10 in lieu of the connection module 24, the service module likewise offering a power pack electrical supply. In connection with the use of an additional service adapter or module 62, the hand-held device 10 can, when so configured, even be operated in a power pack operation. The service module 62, in addition to providing access to an electrical supply cable via a connection to a plug power pack 60, provides accessibility to a serial bus 64 for connection to a PC 66"

WO discloses a light polymerization device comprising: a plurality of modules [see fig.10] including at least a hand-held module 1 [see fig.4], and at least one or more additional modules including a base station 14A [see fig.4], a connection module 15 [see fig.5], and a storage battery module 14, which may be secured [see fig.1] to the hand-held module 1; and a data bus [see fig.14; page 6, lines 1-4] provided between at least two modules via which data, in particular control data for the hand-held module is transferable [see figures 14 and 15]. WO does not disclose specifically a service module. However, WO discloses in fig.14 the hand-held module 1 connected to a computer/power supply, and to a plug power pack 60. Therefore, to use a service module in lieu of a computer connected to a power plug, absent any criticality, is considered to be nothing more than a choice of engineering skill, because neither non-obvious nor unexpected results, i.e., results which are different in kind and not in degree from the results of the prior art, will be obtained as long as the light polymerization device is connected to a power supply and a data bus, as already suggested by WO.

As to claims 2-7, see remarks and reference above. With regard to the particular location, i.e., adjacent to a plurality electrical power supply contacts, absent any criticality, is only considered to be an obvious modification as it has been held by the courts that there would be no invention in shifting the

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location of a structure of a device to another location if the operation of the device would not thereby be modified. *In re Japikse*, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950) MPEP 2144.04

As to claim 8, It would have been obvious to a person having ordinary skill in the art at the time the invention was made to make integral the connection module, the storage battery module, and the service module, since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routing skill in the art. *In re Larson*, 340 F.2d 965, 968, 144 USPQ 347, 349 (CCPA 1965). See MPEP 2144.04. As to an outer configuration which extends flush with a surface of the hand-held module (10), the separation line (26) between the hand-held module (10) and the other modules extends not in a linear manner but in a wavy manner to contribute to the aesthetically pleasing appearance of the device and makes possible an improved anchoring with relatively little construction effort: the court found that matters relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art if a change in shape or configuration is used solely to provide an aesthetically pleasing appearance of the device, and without any criticality, is within the level of skill in the art as the particular shape claimed by applicant is nothing more than one of numerous shapes that a person having ordinary skill in the art will find obvious to provide using routine experimentation based on its suitability for the intended use of the invention. See *In re Seid*, 161 F.2d 229, 73 USPQ 431 (CCPA 1947).

As to claims 10, 11, see remarks and reference above.

As to claims 14, 15, 19, WO discloses microcontroller MC and logic UC [see pages 12,13 and figures 9 and 11]. With regard to the storage battery module being releasably securable, WO discloses "rechargeable" batteries 14 powering the hand-held device, i.e., a battery that could be removed and recharged, in order to provide to be able to refresh the power supply of the hand-held module after extended usage [see fig.1 and page 11].

As to claim 16, WO discloses in fig.5 the connection module 13 is connected with an external electrical supply source via a power pack 14 and the connection module 13 is connectable with at least one of the hand-held device 1 via one of a multi-prong plug [see figures 1 and 5; page 11].

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As to claim 17, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to make integral the connection module 13 and the hand grip of the hand-held module 10, since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routing skill in the art. *In re Larson*, 340 F.2d 965, 968, 144 USPQ 347, 349 (CCPA 1965). See MPEP 2144.04.

7. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over **WO**, as described above, in view of **Wagner et al.** [hereinafter Wagner] [5903462].

WO does not disclose specifically that at least one of an adjustment of the hand-held device into its operational condition, a calibration of the hand-held device and a transmission of data stored in a computer to at least one of the hand-held device, the storage battery assembly, and the base station can be effected.

Wagner discloses in figures 1-21 a hand-held device connected with a computer, such that at least one of an adjustment of the hand-held device into its operational condition, a calibration of the hand-held device and a transmission of data stored in a computer to at least one of the hand-held device, the storage battery assembly. The patent discloses a computer-implemented method and apparatus for controlling a hand-held device, and monitoring the operating parameters of the device. The control is embodied in software embedded on a processor within the device, which also communicates with remote software. An operator can run the device, or through the interaction of both software, operate the device from a remote location, and analyze data from a performance history recorded by the device [see also the abstract; fig.3]. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify WO's apparatus and include software embedded on a processor within the device, as disclosed by Wagner, in order to allow communication with remote software.

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8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Information Disclosure Statement

9. The Information Disclosure Statement (Form PTO-1449) filed 8/6/2003 and 6/24/2005 reference foreign patents described only by abstracts, DE-4116604, and WO-0160280. Since these references seem to read on applicant's instant application, a full translation should be provided.

10. The information disclosure statement filed 6/24/2005 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language, e.g., DE-4211230 and DE-19857613. It has been placed in the application file, but the information referred to therein has not been considered.

11. The information disclosure statement filed 6/24/2005 cites US 6193510, included in the PTO-892 mailed with the Office action of 3/18/2005, which therefore is redundant.

Response to Arguments

12. Applicant's arguments with respect to the claims have been considered but are moot in view of the new grounds of rejection. Applicant amended the independent claim 1 to include both charging and testing the battery, which is new issue.

Conclusion

13. Applicant's submission of an information disclosure statement under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p) on 6/24/2005 prompted the new ground(s) of rejection presented in this

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Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 609.04(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art cited in PTO-892 and not mentioned above disclose related apparatus: **Mann** [5471129], prior art disclosed by applicant, discloses in figures 1-4 a light polymerization device, comprising: a module including at least a base station/recharging unit 10, a hand-held device 12, and a storage battery assembly 68 securable to the hand-held device 12; **Fiebig** [5539297] discloses data bus/conductors 52.1-54.n connecting base stations/modules 1.1-1.n, so that the modules could be switched on/off according to battery parameters [see column 3, lines 49-54]; **Sainsbury et al.** [6104162] discloses in figures 1-6 a connection module 15 connected with an external electrical supply source, and the connection module is connectable with at least one of the hand-held device and the base station [see figures 1 and 2]. The multi-functional power block is capable of being powered from multiple energy sources including, but not limited to, AC mains, DC power or fuel cell, and receiving power from the multi-functional power block and fit into the recess in the hand-held device which receives the power pack [see column 1, lines 66-67; column 2, lines 1-4]; **Brotto et al.** [6218806] discloses a charging apparatus for charging a battery comprising a current source for providing current to the battery, a controller connected to the battery and to the current source for controlling charging of the battery, and a memory connected to the controller for storing information about the battery. The memory may also store information about the charging apparatus. Preferably, the memory is a non-volatile memory, such

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as E²PROM. A battery having a memory for storing information, a power device having a memory for storing information about the device, and a reading apparatus for reading the information stored in the memory of the charger, battery and/or power device are also disclosed. **Brotto** [6175211] discloses in fig. 3, a "**smart battery**" 10, powering a hand-held device, which has an on-board controller 40 (preferably comprising a microprocessor 41), normally powered-up at all times, that can provide to or receive from the charger and/or device data, such as state-of-charge information; by being normally powered, controller 40 can also log and/or store any data as required; **Koenck** [4553081] discloses a "**smart battery**" powering a hand-held device [see fig.1].

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Pia Tibbits whose telephone number is 571-272-2086. If unavailable, contact the Supervisory Patent Examiner Karl Easthom whose telephone number is 571-272-1989. The Technology Center Fax number is 571-273-8300.

16. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PFT

November 6, 2005

Pia Tibbits

Primary Patent Examiner

